

Official Amendment

Serial No. – 10/625,885

Docket No. – UVD 0279 IA / UD 267

REMARKS

Claims 1-104 were pending in the present application. Claims 1, 46, 77, and 102-104 were amended, and claims 2 and 78 were canceled. As a result of this amendment, claims 1, 3-77, and 79-104 are pending. Reexamination and reconsideration are requested in light of the accompanying amendments and remarks.

The provisional rejection of claims 1-5, 8-41, 43, 46-52, 55-58, and 61-67 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 9-43, 50-61, and 68-73 of copending Application Serial No. 10/625,915 has been overcome. A terminal disclaimer accompanies this response.

The provisional rejection of claims 1-5, 8-41, 43, 46-52, 55-58, 61-67, 77, 84-90, and 102-104 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 7-41, 56-67, 74-79, 91, 108, 117, 121-125, and 137-139 of copending Application Serial No. 10/625,886 has been overcome. A terminal disclaimer accompanies this response.

The rejection of claims 1-104 under 35 U.S.C. § 103(a) as being unpatentable over Askew (U.S. Patent No. 5,226,956) is respectfully traversed. Askew teaches a paint or varnish composition comprising a medium and an anti-corrosion agent which is soluble or adapted to be soluble in the medium. The paint or varnish composition can optionally include a conventional drier.

Askew identifies suitable anticorrosion agents as “acids, for example, carboxylic or aromatic acids which may be monobasic or polybasic, unsubstituted or substituted; boron acids; inorganic acids; salts possibly overbased, or esters or partial esters of the above acids; simple or complex amines including polyamines and aminoalcohols; organosulphur compounds; organonitrogen compounds including organic derivatives of various nitrogen acids, optionally thio-substituted; organophosphorus compounds; heterocyclic compounds such as those containing one or more of nitrogen, sulphur, phosphorus, or boron atoms.” Col. 2, lines 43-54.

Official Amendment

Serial No. – 10/625,885

Docket No. – UVD 0279 IA / UD 267

The examiner identified Askew's anticorrosion agent as being a "valence stabilizer." However, the anticorrosion agents of Askew are not valence stabilizers, as claimed. Valence stabilizers help provide a timed release of the inhibitor ion, as well as ensuring that the oxidative strength will not be reduced too rapidly. See e.g., p. 18, line 11 to p. 29, line 18.

The claims recite that the valence stabilizer and the rare earth element are "combined to form a rare earth/valence stabilizer complex." Askew does not teach or suggest that the anticorrosion agents are combined with anything to form a complex, much less combined with a rare earth element to form a rare earth/valence stabilizer complex. Therefore, Askew's anticorrosion agents are not valence stabilizers, as claimed.

The examiner identified Askew's anticorrosion agents as being the "solubility control agent." Solubility control agents adjust the solubility of the rare earth/valence stabilizer complex. For example, pigment formation may result in compounds with greater than optimal solubilities. Solubility control agents can be used to adjust the solubility to the desired range. The solubility control agent is described at p. 337, line 5 to p. 342, line 13. Askew does not teach or suggest that the anticorrosion agents can be used to adjust the solubility of another compound in the composition. Therefore, Askew's anticorrosion agents are not solubility control agents as claimed.

The examiner identified the driers in Askew as being the "rare earth element." The driers, which are optional, are described as being "any conventional drier such as metal containing organic compounds or compositions, for example of cobalt, manganese, calcium, barium or lead, or of rare earth metals such as cerium, often combined with suitable carboxylic acids to ensure their compatibility with the paint medium." Col. 2, line 67 to col. 3, line 5.

The driers of Askew are not the claimed rare earth element. The claims recite that the rare earth element and the valence stabilizer are "combined to form a rare earth/valence stabilizer complex." Askew does not teach or suggest that the driers are combined with anything to form a complex, much less combined with a valence stabilizer to form a rare earth/valence stabilizer complex. As discussed above, there are no valence stabilizers in Askew. Furthermore, the claim

Official Amendment

Serial No. – 10/625,885

Docket No. – UVD 0279 IA / UD 267

also recites that “at least one rare earth element is in the tetravalent oxidation state.” Nowhere in Askew is there any teaching or suggest that the cerium in the driers is in the tetravalent state. Cerium driers, such as cerium octanoate or cerium hexanoate, are known, but these are trivalent compounds, not tetravalent. Therefore, Askew’s driers are not rare earth elements, as claimed.

The examiner also identified the drier as the additional ion of claim 9. However, claim 8, from which claim 9 depends, recites that “the rare earth/valence stabilizer complex has a central cavity containing a cerium, praseodymium or terbium ion and an additional ion.” The specification discusses the additional ion at p. 169, lines 1-15. As discussed above, there is no valence stabilizer, and no rare earth/valence stabilizer complex. Furthermore, Askew does not teach or suggest that the driers contain more than one metal, nor does it teach or suggest the presence of an additional ion in the central cavity containing the rare earth ion. Therefore, the driers of Askew are not the claimed additional ion.

The examiner admitted that Askew does not teach the claimed properties of the corrosion-inhibiting pigment. However, the examiner stated that “because this reference teaches components comparable to that respectively claimed, it would have been obvious to one skilled in the art at the time the invention was made to reasonably expect that the paint or varnish composition of Askew et al. would exhibit these claimed properties in comparable values, absent a showing of convincing evidence to the contrary.” As discussed above, Askew does not teach a valence stabilizer as claimed, a rare earth element as claimed, or a rare earth/valence stabilizer complex as claimed. Therefore, there are no comparable components, and there is no reasonable basis for the expectation of the claimed properties.

Thus, claims 1-104 would not have been obvious to one of ordinary skill in the art at the time the invention was made.

Official Amendment

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Docket No. - UVD 0279 IA / UD 267

CONCLUSION

Applicants respectfully submit that, in view of the above amendment and remarks, the application is now in condition for allowance. Applicants respectfully request that claims 1, 3-77, and 79-104 be passed to allowance.

If the Examiner has any questions or comments regarding the present application, he is invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,
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